REMARKS

Claims 1-18 are all the claims presently pending in the application. Claims 1-7 have been amended to more particularly define the invention. New claims 8-18 have been added to assure Applicant the degree of protection to which his invention entitles him.

It is noted that the claim amendments herein or later are <u>not</u> made to distinguish the invention over the prior art or narrow the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein or later should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

With respect to the prior art rejections, claims 1-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Logan et al. (U.S. Patent No. 5,732,216).

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention is directed to a voice banner advertisement system, a Web server for performing an advertisement to a user terminal, a user terminal for uttering received advertisement data with voice, and a voice banner advertisement method for performing an advertisement with voice.

An exemplary aspect of the present invention, as recited in claim 1, provides a voice banner advertisement system for performing an advertisement with voice including a Web server including a Web page data transmission means for constituting Web page data comprising contents data and banner advertisement data to be offered to a user and

transmitting the Web page data and a history information recording means for recording as

history information the number of times which a banner advertisement is transmitted, and a

user terminal including a communication means for performing data communication with the

Web server through a network, a Web page browsing means for browsing the Web page data

offered by the Web server, and a voice synthesis means for extracting the banner

advertisement data from the received Web page data and converting the banner advertisement

data into voice by voice synthesis to utter the banner advertisement data.

Another aspect of the invention, as recited in claim 4, is directed to a user terminal for

uttering received advertisement data with voice including a communication means for

performing data communication with a Web server through a network, a Web page browsing

means for receiving Web page data offered by the Web server to browse the Web page data,

and a voice synthesis means for extracting banner advertisement data from the received Web

page data and converting the banner advertisement data into voice by voice synthesis to utter

the banner advertisement data.

In yet another aspect, as recited in claim 6, a voice banner advertisement method for

performing an advertisement with voice includes constituting Web page data including

contents data and banner advertisement data offered to a user, transmitting the Web page data

to the user, recording the number of times which the banner advertisement data is transmitted

as history information, extracting the banner advertisement data from the received Web page

data, and converting the banner advertisement data into voice by voice synthesis to utter the

banner advertisement data.

A further aspect of the present invention, as recited in claim 14, is directed to a portable terminal with a small-area information display including a voice synthesis means for extracting banner advertisement data from Web page data received from a Web server through a network and converting the extracted banner advertisement data into voice data which is uttered through voice synthesis.

Conventional techniques for providing banner advertising on web pages on the Internet involve dedicating a portion of the display area of a display to the banner advertisement. In terminals having a large-area display, such techniques are suitable since the advertisement display area is relatively much smaller than the contents display area. (See Application at page 1, lines 10-17)

However, in recent years, Internet access has expanded to portable devices, such as portable phones, which have compact display units. In such devices, banner advertisements considerably reduce the amount of content that can be displayed, and thus are not practical. (See Application at page 1, lines 18-27)

The claimed invention, on the other hand, extracts banner advertisement data from received Web page data and converts the banner advertisement data into voice. In this manner, the advertisement can be expressed with voice in place of text and/or images. Thus, the banner advertisement need not be displayed or can be dramatically minimized. Therefore, the contents desired by the user can be maximally displayed on the portable terminal. (See Application at page 9, lines 7-12)

II. THE LOGAN ET AL. REFERENCE

The Examiner alleges that the Logan et al. reference anticipates the claimed invention. However, Applicant submits that there are elements of the claimed invention which are neither taught nor suggested by Logan et al.

Logan et al. discloses an audio program and message distribution system in which a host system organizes and transmits program segments to client subscriber locations. (See Logan et al. at Abstract)

The Examiner concedes that Logan et al. does not teach banner advertisements, as recited in claims 1-7. Rather, the Examiner attempts to make up for the deficiencies of Logan et al. by asserting that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate banners into the advertising data disclosed in Logan et al. because, as alleged by the Examiner, banner advertisements were well known in HTML and their use for advertising likewise well known.

Applicant respectfully notes that the present Application claims priority to Japanese Application 2000-347901 filed November 15, 2000. Thus, the Examiner has taken official notice that banner advertisements on web pages were well-known in the art as of at least November 15, 2000. Applicant respectfully disagrees and requests the Examiner to produce authority for this contention.

Furthermore, Applicant submits that the modification alleged by the Examiner is improper. Indeed, no person of ordinary skill in the art would have considered incorporating banner advertisements into the disclosure of Logan et al. absent impermissible hindsight.

In fact, Applicant submits that the Examiner can point to <u>no motivation or suggestion</u> in Logan et al. or otherwise to incorporate banner advertisements, as alleged by the Examiner. Indeed, the reference does <u>not</u> teach or suggest the combination.

Therefore, Applicant respectfully submits that one of ordinary skill in the art would <u>not</u> have been so motivated to incorporate banner advertisements into the teachings of Logan et al., as alleged by the Examiner. Therefore, the Examiner has <u>failed to make a prima facie case of obviousness</u>.

Notwithstanding the above, Applicant respectfully submits that, even assuming <u>arguendo,</u> that the incorporation of banner advertising into the teachings of Logan et al is proper, the combination would <u>not</u> teach or suggest each and every element of the claimed invention.

Indeed, Logan et al. further fails to teach or suggest <u>extracting banner advertisement data from the received Web page data, and converting the banner advertisement data into voice by voice synthesis to utter the banner advertisement data</u>, as recited the claimed invention.

Rather, Logan et al. discloses that a host server 101 periodically transmits <u>a download compilation file</u> 145 upon receiving a request from the player 103 (e.g. laptop PC) of a subscriber. The file includes a <u>series of compressed various multi-media segments and advertisement segments</u> based on a subscriber's selections and preferences. The file 145 is placed in an <u>FTP download directory</u> and, at a time determined by the player, a connection is established with the Internet, and <u>the FTP server</u> 125 downloads <u>the compilation file</u> to the player for the user's perusal. (See Logan et al. at column 5, lines 45-62)

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However, Logan et al. does <u>not</u> teach or suggest that <u>advertising data</u> should be extracted from the <u>downloaded compilation file</u> 145 or that the <u>extracted advertising data</u> should be converted to voice by the voice synthesizer. Logan et al. certainly does <u>not</u> teach or suggest these features to <u>maximize</u> the area of a display in which content can be displayed on a portable terminal, as in the present invention.

Further, the <u>compilation file</u> 145 in Logan et al. is <u>not</u> included in the <u>web page data</u> that is transmitted to the user. (See Logan et al. at Figure 1 and column 5, lines 32-44) Logan et al. discloses that "[t]he host server 101 further stores <u>web page data</u> 141 which is made available to the player 103 by means of <u>the HTML interface</u>." (Logan et al. at column 5, lines 32-34) However, as noted above, transfer of the compilation file, which includes the advertising data, is accomplished via the <u>FTP server</u>. Thus, the advertising data is <u>not</u> included in the <u>web page data</u> and <u>cannot</u> be extracted from the <u>web page data</u>, as in the claimed invention.

Therefore, even assuming <u>arguendo</u> that banner advertising data were incorporated into the advertising data of Logan et al., as asserted by the Examiner, it would <u>not</u> yield the claimed invention. Clearly, the incorporation of banner advertisements does <u>not</u> make up for the deficiencies of Logan et al.

In light of the above, Applicant submits that there are elements of the claimed invention that are <u>not</u> taught or suggest by Logan et al. and respectfully requests the Examiner to withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

Applicant notes that the present Application claims foreign priority benefits under 35 U.S.C. § 119 of Japanese Patent Application 2000-347901 filed November 15, 2000, a certified copy of which was submitted on January 24, 2002. <u>Applicant respectfully requests the Examiner to acknowledge on the Office Action Summary (form PTOL-326) that "all" the priority documents have been received</u>.

In view of the foregoing, Applicant submits that claims 1-18, all the claims presently pending in the application, are patentably distinct over the prior art of record and are allowable, and that the application is in condition for allowance. Such action would be appreciated.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below to discuss any other changes deemed necessary for allowance in a telephonic or personal interview.

To the extent necessary, Applicant petitions for an extension of time under 37 CFR §1.136. The Commissioner is authorized to charge any deficiency in fees, including

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extension of time fees, or to credit any overpayment in fees to Attorney's Deposit Account

No. 50-0481.

Respectfully Submitted,

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